

REMARKS**I. General**

Claims 1 – 20 are pending in the current application. Claims 21 – 23 have been added by the present amendment. Accordingly, claims 1 – 23 will be pending after entry of the present amendment.

The following are the outstanding issues in the current application:

- Claims 1 – 3, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,893,080 (filed Jul. 25, 1995) (issued Apr. 6, 1999) to McGurl et al. (hereinafter “McGurl”).
- Claims 10 – 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,401,079 (filed Oct. 1, 1999) (issued Jun. 4, 2002) to Kahn et al. (hereinafter “Kahn”).
- Claims 4, 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McGurl as applied to claim 1 and further in view of Kahn.
- Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McGurl as applied to claim 1 and further in view of U.S. Patent 6,032,133 (filed Nov. 3, 1995) (issued Feb. 29, 2000) to Hilt et al (hereinafter “Hilt”).

Applicants hereby traverse the outstanding rejections. Accordingly, Applicants respectfully request reconsideration and withdrawal in light of the remarks contained herein.

Claim 10 has been amended to correct an informality. Specifically, claim 10 now reads, “supervising” instead of “supvising.” This amendment does not introduce any new matter and does not alter the scope of the claim.

Applicants have added claims 21 – 23. Claims 21 – 23 introduce no new matter. The subject matter of these new claims is present in the specification, *inter alia*, at paragraphs [0013] & [0014]; Fig. 2, items 204, 211 and 212. The new claims, claims 21 – 23, are patentable over the art of record because the art of record does not disclose an authorization process that requires a determination whether an individual, apart from the individual requesting the disbursement, should approve a particular request.

II. Rejections Under 35 U.S.C. § 102

Claims 1 – 3, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by McGurl. Claims 10 – 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kahn.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The claims rejected, in the current application, under 35 U.S.C. § 102 are patentable over the applied art. The failure of the applied art to anticipate the rejected claims is discussed below.

A. Rejections Under 35 U.S.C. § 102(b)

1. The Independent Claim

a. Claim 1

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by McGurl. Claim 1, recites, “an authorization process configured to apply predetermined rules to control verifying proper authorization of said disbursement requests” In McGurl, as cited by Examiner, there is no teaching of the authorization of disbursement requests. Rather, the

cited portion of McGurl teaches, the system is monitored and “[i]f a **fault condition** is determined to exist anywhere in the system, the monitoring means prevents the effectuating mechanisms” Col. 6, lines 8 – 12 (emphasis added). Further, McGurl, as cited by Examiner also provides that “[f]unctioning of the system ... is monitored ... and if it is determined to be improper, disbursement is aborted, and the user is notified of the **failure condition**” Col. 6, lines 28 – 32 (emphasis added). McGurl, as cited by Examiner does not teach that a “fault condition” or a “failure condition” constitutes an absence of proper *authorization* of a disbursement request or teaches anything whatsoever about authorization of a disbursement request. McGurl, therefore does not disclose authorization of disbursement request or, at least, does not disclose a system in sufficient detail as to require proper authorization of disbursement requests. *See Suzuki Motor Co.*, 9 USPQ2d at 1920 (requiring that for a claim to be anticipated “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.”).

Furthermore, because McGurl does not teach the authorization of disbursement requests, McGurl does not teach the further limitation of claim 1 reciting, “an accounting process configured to track parameters pertaining to the fulfillment of authorized ones of said disbursement requests” Examiner’s citation to McGurl pertaining to this limitation merely teaches that the information used in generating the disbursement is stored in a data base and that a disbursement log is kept. There is no teaching, in this citation to McGurl, that an accounting process tracks the parameters of authorized disbursement requests.

Because McGurl does not teach the authorization process recited in claim 1 and consequently the tracking of parameters pertaining to authorized disbursement requests, McGurl does not anticipate claim 1 under 35 U.S.C. § 102(b). Accordingly, Applicants respectfully request that Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 102(b).

2. The Dependent Claims

a. Claims 2 – 3, 8 and 9

Claims 2– 3, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by McGurl. Claims 2– 3, 8 and 9 depend from claim 1 and therefore inherit the limitations of claim 1. As discussed above, McGurl does not teach all the limitations of claim 1. Therefore, McGurl does not teach all the limitations of claims 2 – 3, 8 and 9. Claims 2 – 3, 8 and 9 are, therefore, patentable. Accordingly, Applicants respectfully request that Examiner withdraw the rejection of claims 2 – 3, 8 and 9 under 35 U.S.C. § 102(b).

B. Rejections Under 35 U.S.C. § 102(e)

1. The Independent Claims

a. Claim 10

Claim 10, recites, “applying predetermined rules to authorize said disbursement request” Examiner cites to the Abstract and col. 15 lines 20 – 31 of Kahn as teaching this limitation of claim 1. However, the Abstract and col. 15 lines 20 – 31 do not teach this limitation of claim 10. The Abstract and col. 15 lines 20 – 31, teach that tax related and employment related rules for various federal, state and local jurisdictions are used to compute the amount to be disbursed. Kahn does not include rules that authorize the disbursement request. Therefore, the cited portions of Kahn do not teach the limitation applying predetermined rules to authorize said disbursement request as recited in claim 10.

Claim 10 also recites, “supervising the proper approval based on applied ones of said authorization rules” Examiner cites to col. 5, lines 25 – 35 of Kahn for this limitation of claim 10. However, this citation merely teaches the implementation of tax related and employment related rules that affect the amount disbursed, as opposed to applying authorization rules as required in claim 10.

In sum, Kahn, as cited by Examiner, does not teach all the limitations of claim 10 and thus does not anticipate claim 10. Accordingly, Applicants respectfully request that Examiner withdraw the rejection of claim 10 under 35 U.S.C. § 102(e).

b. Claim 19

Claim 19 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Kahn. Claim 19, recites, “an authorization module configured to control proper authorization of said payment requests to provide approved payments” Examiner cites to col. 54, lines 54 – 56, col. 55 lines 1 – 46 and col. 56 lines 46 – 50 as teaching this limitation of claim 19. Applicants respectfully disagree that these cited portions of Kahn teach this limitation of claim 19.

First, col. 54 lines 54 – 56 is the preamble to claim 6 that recites, “A method for interactive payroll-related calculations” This citation to Kahn does not teach an authorization module configured to control proper authorization. Second, col. 55, lines 1 – 46, does not teach an authorization module but, rather, consistent with the preamble of claim 6, teaches a method for performing calculations, communicating the results of the calculations to the employer, reviewing the data by the employer and the making of necessary modifications by the employer. Third, col. 56, lines 46 – 50 teach that the employer indicates when there are no more errors to correct. Thus, the Kahn process is directed only to ensuring the amount to be paid is correct and does not involve ensuring proper authorization of payment requests to provide approved payments, as required in claim 19.

Claim 19 also recites, “a payment module configured to initiate payment to recipients designated in connection with said approved payments in response to said verification of fund availability and said proper authorization.” Examiner cites to Fig. 3, item 1140 of Kahn as teaching these limitations of claim 19. Fig. 3, item 1140 is labeled “move money” and Fig. 3 shows money being moved to several sources in the Kahn payroll administration system. Significantly, however, Fig. 3 does not teach that, the movement of money in Fig. 3

is in association with approved payments or is in response to verification of fund availability and proper authorization. Therefore, Kahn, as cited by Examiner, does not teach an invention in sufficient detail as to require, a payment module configured to initiate payment to recipients designated in connection with approved payments in response to verification of fund availability and proper authorization, as required by claim 19. *See Suzuki Motor Co.,* 9 USPQ2d at 1920 (requiring that for a claim to be anticipated [t]he identical invention must be shown in as complete detail as is contained in the ... claim.”).

In sum, Examiner has failed to show Kahn teaches all the limitations of claim 19 and thus, that Kahn anticipates claim 19. Accordingly, Applicants respectfully request that Examiner withdraw the rejection of claim 19 under 35 U.S.C. § 102(e).

2. The Dependent Claims

a. Claims 11 – 18 and 20

Claims 11 – 18 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kahn. Claims 11 – 18 depend from claim 10 and therefore inherit the limitations of claim 10. Claim 20 depends from claim 19 and therefore inherits the limitations of claim 19. As discussed above, Kahn does not teach all the limitations of claims 10 or 19. Therefore, Kahn does not teach all the limitations of claims 11 – 18 and 20. Claims 11 – 18 and 20, therefore, are patentable. Accordingly, Applicants respectfully request that Examiner withdraw the rejection of claims 11 – 18 and 20 under 35 U.S.C. § 102(e).

III. Rejections Under 35 U.S.C. § 103(a)

Claims 4, 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McGurl as applied to claim 1 and further in view of Kahn. Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McGurl as applied to claim 1 and further in view of Hilt.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. M.P.E.P. § 2142; *In re Peehs*, 612 F.2d 1287, 204 USPQ 835, 837 (CCPA 1980). To establish a *prima facie* case of obviousness, three basic criteria must be met. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991)). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. *Id.*

1. Claims 4, 6 and 7

Claims 4, 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McGurl as applied to claim 1 and further in view of Kahn. As discussed above, McGurl does not teach all the limitations of claim 1. Examiner does not rely on Kahn for the limitations of claim 1. The combination of McGurl and Kahn, therefore, does not teach all the limitations of claim 1. Claims 4, 6 and 7 depend from claim 1 and inherit the limitations of claim 1. Consequently, Examiner has failed to establish a *prima facie* case of obviousness of claims 4, 6 and 7. Accordingly, Applicants respectfully request that Examiner withdraw the rejection of claims 4, 6 and 7 under 35 U.S.C. § 103(a).

2. Claim 5

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over McGurl as applied to claim 1 and further in view of Hilt. As discussed above, McGurl does not teach all the limitations of claim 1. Examiner does not rely on Hilt for the limitations of claim 1. The combination of McGurl and Hilt, therefore, does not teach all the limitations of claim 1. Claim 5 inherits the limitations of claim 1. Consequently, Examiner has failed to establish a

prima facie case of obviousness of claim 5. Accordingly, Applicants respectfully request that Examiner withdraw the rejection of claim 5 under 35 U.S.C. § 103(a).

IV. Conclusion

In view of the above, Applicants believe the pending application is in condition for allowance. The required fee for this response is reflected on the transmittal sheet. If any additional fee is due, please charge Deposit Account No. 08-2025, under Order No. 10011295-1, from which the undersigned is authorized to draw.

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